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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
1811

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Typed or printed
name Lawrence H. Aaronson

Application Number
10/071,833

Filed
February 7, 2002

First Named Inventor
Von K. McConnell

Art Unit
2143

Examiner
Kyung H. Shin

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.

Registration number 35,818

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

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January 30, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Sprint Docket No. 1811)

In re Application of:)	
)	
Von K. McConnell)	
)	Group Art Unit 2143
Serial No. 10/071,833)	
)	Examiner: Kyung H. Shin
Filed: February 7, 2002)	
)	Confirmation No. 2846
For: METHOD AND SYSTEM FOR)	
FACILITATING SERVICES IN A)	
COMMUNICATION NETWORK)	
THROUGH DATA-PUBLICATION)	
BY A SIGNALING SERVER)	

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REASONS FOR REVIEW OF FINAL REJECTION

Applicant requests review of the final rejection mailed September 9, 2005, because the Examiner has clearly not set forth a sufficient basis for rejecting any of the pending claims.

1. The Claimed Invention

This application includes six independent claims: 1, 3, 12, 17, 26, and 36. These claims are directed to a method and system in which a signaling server makes data available for use by an application server to carry out a communication service.

Claims 1, 3, 12, 17, and 26 are all directed in various ways to a scenario where (a) a signaling message passes through (i.e., is received and then forwarded by) a network entity to an application server, and (a) the network entity also responds to receipt of the signaling message by (i) extracting from a data store a set of data usable by the application server to carry out a

communication service and (ii) making that extracted data available for use by the application server to facilitate carrying out the service.

Claim 36, in turn, is directed to a method that includes receiving into a registration server a signaling message indicating that a user is online, and the registration server responsively extracting from a data store a buddy-list for the user and making the buddy list available for use by an application server in setting up a communication for the user.

2. Clear Error by the Examiner

In the final office action, the Examiner maintained anticipation rejections of independent claims 1, 3, 17, 26, and 36 over Maggenti, and the Examiner maintained an obviousness rejection of claim 12 over Maggenti and Holden. Applicant submits that the Examiner has clearly erred in these rejections, because the Examiner has not established that Maggenti teaches each and every element of any of claims 1, 3, 17, 26, or 36, and the Examiner has not established that the Maggenti/Holden combination discloses or suggests each and every element of claim 12.

In Applicant's response filed July 5, 2005, and again in Applicant's response after final filed October 31, 2005, Applicant pointed out the clear deficiencies of Maggenti in terms of Applicant's claim language. Yet, in the final office action and again in the advisory action, while the Examiner noted that Maggenti teaches certain concepts (such as the concept of a proxy server working between two signaling endpoints and the concept of SIP signaling generally), the Examiner did not substantively address or overcome the particular deficiencies pointed out by Applicant.

For the reasons set forth in Applicant's previous responses, Applicant maintains that Maggenti does not anticipate any of claims 1, 3, 17, 26, and 36, and that the Maggenti/Holden

combination does not render obvious claim 12. Further, Applicant maintains that the dependent claims patentably distinguish over Maggenti and Holden for at least the same reasons.

In the following sub-sections, Applicant will highlight some of the clear deficiencies of the Examiner's rejections. For a more full discussion, however, Applicant respectfully refers the panel to the "Remarks" section of the response after final.

i. Claims 1 and 3

Maggenti does not teach the combined functions of (1) receiving a signaling message (e.g., initiation message), (2) responsively extracting from a data store a set of data usable by an application server (or endpoint application) to carry out a communication service (e.g., setting up the communication), and (3) outputting the signaling message for transmission to the application server and making the set of data available for use by the endpoint application to set up the communication, as recited in claims 1 and 3.

At best, Maggenti teaches having a communication manager (CM) receive a SIP INVITE message from a communication device (CD) and responsively generate and send to the CD a SIP 200 OK message. As Applicant has explained, the *response message* (200 OK) generated by the CM in that scenario is clearly not *the signaling message* received by the CM (or even the signaling message with one or more via headers added). It is, rather, an altogether different message. The Examiner has not disputed this point. Consequently, Applicant maintains that Maggenti clearly does not anticipate claims 1 and 3.

ii. Claim 17

Maggenti does not teach a system that extracts data from a user-profile store in response to a session initiation message and makes that data available for use by an endpoint application to which the system sends the session initiation message that it receives, as recited in claim 17.

Here, the same deficiency noted above exists. Namely, Maggenti's disclosure of a CM sending a *response* message to a CD cannot constitute a disclosure of the system recited in claim 17, since the response message is not the session initiation message (or any variation of the session initiation message) that the CM receives in the first place.

In responding to Applicant's arguments on this point, the Examiner argued in the advisory action that the CM can function as a proxy server for signaling between two CDs. Yet the Examiner has not pointed to any teaching in Maggenti of a system having in data storage both the proxy-server logic and data-management logic recited in claim 17. Thus, even if the CM could function as a proxy server, it does not also have the data-management logic that Applicant claims. Thus, Applicant still maintains that Maggenti clearly does not anticipate claim 17.

iii. Claim 12

Maggenti fails to teach the invention recited in claim 12, largely for the same reasons noted above with respect to claims 1, 3, and 17, and Applicant submits that Holden fails to make up for the deficiency of Maggenti. Thus, Applicant maintains that the Examiner has not established *prima facie* obviousness of claim 12.

iv. Claim 26

Maggenti does not teach any platform that (i) receives a session initiation message and forwards the session initiation message along to an application server and (ii) extracts from a profile store data usable by the application server to facilitate performance of a service in response to the session initiation message and makes the data available for use by the application server to facilitate performance of the service, as recited in claim 26.

Although Maggenti teaches the endpoint CM application server extracting data from a database to facilitate carrying out a communication service, the CM application server cannot constitute a platform that sends the session initiation message to the CM application server, since

that would mean the CM application server would send a message to itself, which would be illogical. Consequently, the disclosure of Maggenti cannot amount to the invention as recited in claim 26. The Examiner has not disputed this point. Thus, Applicant maintains that Maggenti clearly does not anticipate claim 26.

v. Claim 36

Maggenti does not teach a method that involves (i) receiving into a registration server a signaling message indicating that a user is online in a communication network, and (ii) the registration server responsively extracting from a data store a buddy-list designated for the user, and the registration server making the buddy-list available for use by an application server in setting up a communication for the user, as recited in claim 36.

In rejecting claim 36, the Examiner asserted that Maggenti generally teaches the functions of extracting a buddy-list from a data store and making the buddy-list available. However, the Examiner has not asserted that Maggenti teaches *a registration server responsively* extracting a buddy-list from a data store and *the registration server* making the buddy-list available for use by the application server. Because claim 36 recites that a registration server carries out these functions, but Maggenti does not teach any such registration server, Applicant maintains that Maggenti clearly does not anticipate claim 36.

3. Conclusion

In view of the foregoing, Applicant submits that the claim rejections should be withdrawn and all of the pending claims should be allowed.

Respectfully submitted,
McDONNELL BOEHNEN
HULBERT & BERGHOFF LLP

Date: January 30, 2006

By:



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